

REMARKS

THE REJECTIONS BASED ON THE ALLEGED AAPA

In the outstanding office action, all of the claims were rejected on the basis of the disclosure in the present application that the Examiner has characterized as “Applicant’s Admitted Prior Art” either standing alone, or in combination with certain other art of record. As has been pointed out previously and as is believed to be fully understood by the Examiner, the inventors believe that the lead frame illustrated in Fig. 1(a) and 1(b), as well as the package illustrated in Fig. 1(c), is part of their invention. It is the undersigned’s understanding that the Examiner’s position is that because these figures were described in the background section of the Application and further because of the prosecution history that has occurred to date, the Applicant’s cannot overcome or correct this mischaracterization of the Figs. 1(a)-1(c) and their corresponding descriptions in the specification. For the reasons set for the below, that position is respectfully traversed.

MPEP §2129 - A discussion of Applicant’s own prior work cannot be treated as prior art in the absence of a statutory bar.

The Examiner appears to be aware of the general rule articulated in Section 2129 of the MPEP that admissions by applicant regarding the work *of others* may generally be treated as prior art. However, MPEP §2129 continues by pointing out (citing *Reading & Bates*)¹ that: **“[a]n applicant’s own foundational work should not, unless there is a statutory bar, be treated as prior art solely because knowledge of this work is admitted.”** In the present case, the portions of the specification referred to by the Examiner as Applicant’s Admitted Prior Art is the Applicant’s own foundational work and the Applicant’s are unaware of any existing statutory bars. Accordingly, it is respectfully submitted that the pending art based rejections should be withdrawn.

It is noted that MPEP §2129 includes a discussion of the cases, *In re Nomiya*, *Reading & Bates* and others. These cases highlight the distinctions regarding admissions made by an applicant in regard to the work *of others* vs. discussions of their own prior work. In the present case, the background section of the originally filed application described a lead frame and package design (illustrated in Figs. 1(a)-1(c)) **that was the inventors’ own work**. In situations where a discussion in the background describes the applicant’s own work that is not the subject

¹ *Reading & Bates Construction Co. v. Baker Energy*, 223 USPQ 1168 (Fed. Cir. 1984).

of any known statutory bar, such a discussion **should not** be and cannot be treated as an irrevocable admission of prior art.

It is noteworthy that the relevant drawings (Figs. 1(a)-1(c)) as originally filed WERE NOT labeled as prior art. During prosecution, Applicant's previous counsel made an amendment to the drawings labeling Figs. 1(a)-1(c) as prior art without first checking with the inventors. The inventors have unequivocally stated that the subject matter of Figs 1(a)-1(c) (which is the same subject matter that the amendments sought to move from the background to the detailed description portion of the application) is their own work and, to the best of their knowledge, not subject to any statutory bars. Therefore, it is respectfully submitted that any presumption that the subject matter of Figs. 1(a)-1(c) is prior art that may have been implied by discussing this work in the background section of the application has been successfully rebutted by the inventors statements that those figures illustrate their own work and that they are unaware of any events that would cause that work to constitute a statutory bar. So that the record is clear, a declaration of the inventors stating that Figs. 1(a) – 1(c) illustrate their own work accompanies this amendment.

Since the subject matter of Figs. 1(a)-1(c) illustrate the inventors' own work, it is respectfully submitted that they may, as a matter of right, eliminate any inference in the application that such work is somehow prior art to them and that the pending rejections based on Figs. 1(a)-1(c) or the corresponding text must be withdrawn. Since all of the pending art based rejections use the disclosure in the background section of the application and Figs. 1(a)-1(c) as their primary reference, it is respectfully submitted that all of the pending art based rejections should be withdrawn.

The cap that covers a 2-D array of device areas feature

Several of the claims, including claims 22, 26-33 and 38-44 are directed at panel assemblies suitable for use in packaging a 2-D array of integrated circuits simultaneously. The panel assembly includes a lead frame panel patterned to define at least one two dimensional array of adjacent device areas that are each suitable for use as part of an independent integrated circuit package. These claims further require a molded cap that covers the array of device areas. The Examiner has acknowledged that the prior art fails to teach the specific use of a cap, but

argues it is an obvious variation of applicant own prior art. This assertion is respectfully traversed. This was a point addressed in the previous interview that occurred with the Examiner and it is respectfully submitted that the Examiner's failure to find a reference that in the context of the claimed invention (e.g. a panel suitable for forming leadless leadframe type packages) utilizes a cap that encapsulates a 2-D array of device areas is strong evidence that the use of such an integrated cap is non-obvious. It is further respectfully submitted that the array cap is not in any way an obvious variation of Fig. 1(a) standing alone since the device areas could readily be molded individually as appears to be the case in virtually all of the lead frames based art of record.

OBJECTIONS TO THE AMENDMENT FILED 4-26-02

The outstanding office action objected to the amendments filed April 26, 2002 on the basis that they introduce new matter. The asserted new matter includes the removal of any suggestion that may be interpreted as suggesting that Figs. 1(a) – 1 (c) constitute prior art. Other asserted new matter appears to be the identification of the tie bars.

MPEP §2163.06 – REARRANGEMENT OF THE SPECIFICATION DOES NOT CONSITUTE NEW MATTER

The amendments to the specification that have been objected to by the Examiner merely move the description of Figs. 1(a) – 1(c) from the background section to the detailed description section of the application. With the exception of the discussion of the tie bars (which is addressed below), the Examiner has not asserted that the amendments to the specification change the technical description of the illustrated subject matter of the application as originally filed. Furthermore, the undersigned believes that the amendments do not in any way change the technical description of the original application. It is also respectfully submitted that the Examiner's position is in direct conflict with PTO policy. Specifically, Section 2163.06 of the MPEP states (first paragraph, third sentences) "**information contained in any one of the specification, claims or drawings of the application *as filed* may be added to *any other part of the application without introducing new matter.***" Accordingly, it is respectfully submitted that the outstanding objections to the amendments to the specification should be withdrawn. More specifically, it is respectfully submitted that moving the description of Figs. 1(a)-1(c) from the background section of the application to the detailed description should not be treated as new matter. Since the proposed amendment is in complete compliance with the MPEP as quoted

above, the Applicants request that the Examiner's pending objection to the amendment filed April 26, 2002 be withdrawn.

THE TIE BARS

The Examiner also apparently objected to the identification of the tie bars in the amendments to the specification. This objection is also respectfully traversed. The tie bars are very clearly shown (although not explicitly labeled) in the originally filed drawings of Figs. 1(a), 1(b), 2(a), and 2(b) in a manner that can be clearly and unequivocally understood by those of ordinary skill in the art. As pointed out above, Section 2163.06 of the MPEP provides that "information contained in any one of the specification, claims or drawings of the application *as filed* may be added to *any other part* of the application *without* introducing new matter." In this case, the tie bars are clearly shown in the drawings and their layout in a grid of perpendicular rows and columns that define the respective device areas is clearly shown in the drawings. Therefore, it is respectfully submitted that the amendments to the specification relating to the description of the tie bars do not in any way constitute new matter. Accordingly, it is respectfully requested that the Examiner withdraw the pending objection to the amendments filed April 26, 2002 for this reason as well.

REJECTIONS BASED ON 35 USC 112

The Examiner has rejected claims 11, 13, 18, 34, 36 and 38 as containing subject matter not described in the specification in a way as to reasonably convey the invention to one skilled in the art. These rejections are respectfully traversed.

With respect to the tie bars and their geometric layout, as discussed above, the amendment filed April 26th, 2002 identifies the tie bars that are illustrated in Fig. 1(a) and points out that they are laid out in a grid of perpendicular rows and columns (which inherently defines a matrix and/or a two dimensional array of device areas). These features were clearly shown in Figs. 1(a), 1(b), 2(a), and 2(b) of the originally filed drawings.

With respect to the sharp corners and the rectangular footprint. Although it is respectfully submitted that the drawings (e.g. Figs. 1(c) and 2(b)) clearly show the sharp corners and that the description of sawing to singulate the devices makes it clear that the corners are sharp, the relevant claims 34 and 36 have been canceled. Applicant reserves the right to reintroduce claims of the same scope in a continuation application.

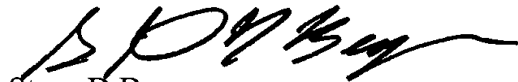
OBJECTIONS TO THE DRAWINGS

The drawings were objected to for failing to show the tie bars. As discussed above, it is respectfully submitted that the drawings do indeed show the tie bars. The proposed corrected drawings submitted herewith numerically label the tie bars.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all pending claims are allowable and the Applicant respectfully requests a Notice of Allowance for this application from the Examiner. If any fees are due in connection with the filing of this amendment, such fees may be charged to our Deposit Account No. 50-0388 (Order No. NSC1P217D2).

Respectfully submitted,
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